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1774

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,168	12/05/2000	Jun Takahashi	108053	6589

7590 02/17/2004

Oliff & Berridge PLC
P.O. Box 19928
Alexandria, VA 22320

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
1774	

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DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/729,168

Applicant(s)

TAKAHASHI ET AL.

Examiner

Betelhem Shewareged

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 13 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 13 January 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached Detailed Action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1, 2 and 7.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DETAILED ACTION

1. Applicant's response filed on 01/13/2004 has been fully considered. Claim rejection to claims 1, 2 and 5-7 under 35 U.S.C. 103(a) as being unpatentable over Hasegawa et al (US 5,027,131) in view of Asano et al. (EP 0 818 322 A1) has been withdrawn in view of Applicant's amendment and comment.
2. Claim 1 is amended, claims 3-6 are cancelled, and thus claims 1, 2 and 7 are pending.

Claim Rejections - 35 USC § 103

3. Claims 1, 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamoto et al. (US 6,139,940) in view of Asano et al. (EP 0 818 322 A1).

Iwamoto discloses an ink jet recording sheet having a substrate, an ink absorbing layer onto the substrate, and an ink permeable layer onto the ink absorbing layer (abstract). The substrate may be transparent (col. 2, line 56). The ink permeable layer comprises inorganic pigments and a resin (col. 2, line 35). Examples of the resin are acrylic, polyester, polyurethane, styrene-butadiene, vinyl acetate, vinyl chloride, and polyvinyl butyral (col. 2, lines 40-46). Iwamoto fails disclose a resin having a glass transition temperature as claimed.

Asano teaches an ink jet recording sheet having a substrate, an ink receiving layer on the substrate, and a gloss layer on the ink receiving layer (page 3, lines 5-8). The ink receiving layer is equivalent to the claimed ink absorbing layer, and the gloss layer is equivalent to the claimed ink permeable layer. The gloss layer comprises a

pigment and a resin, and is porous and ink permeable (page 5, line 43-46). The resin has a glass transition temperature of 40°C or more, preferably 50-100 °C (page 6, line 36). Examples of the resin are polyvinyl alcohol, acrylic, polyurethane, vinyl acetate, vinyl chloride, and acrylamide (page 5, line 56 thru page 6, line 10).

Iwamoto and Asano are analogous art because they are from the same field of endeavor that is the ink jet recording art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the ink permeable layer of Asano with the invention of Iwamoto in order to optimize the porosity of the gloss layer which in turn controls the ink absorbing properties of the layer (page 6, lines 36-44 of Asano).

With respect to the hardness value it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Asano reference teaches Applicant's claimed compositional limitations of the ink permeable layer, it is inherent that the reference gloss layer function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Response to Arguments

4. Applicant's argument is based on that Iwamoto does not include an ink permeable layer, instead Iwamoto discloses an ink impermeable layer, and Asano

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teaches ink permeable gloss layer. Therefore, one skilled artisan would not expect that an element of an ink permeable layer should be employed in an ink impermeable layer. Applicant's argument has not been found persuasive for the following. Even though Iwamoto discloses an ink impermeable layer, this layer of Iwamoto does not absorb ink (col. 1, line 65), therefore, the Examiner interprets that the ink is being transported to the next layer, which is the ink absorbing layer. Asano teaches a porous gloss layer which allows the ink to be transported to the ink receiving layer (page 5, line 45). Both Iwamoto and Asano teach a layer that transports ink to the next layer such as ink absorbing layer or ink receiving layer, therefore, one of ordinary skill in the art would have been motivated to combine the teachings of Iwamoto and Asano, and a *prima facie* case of obviousness has been made.

For the above reason, the claims 1, 2 and 7 stand rejected.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Betelhem Shewareged
February 10, 2004.

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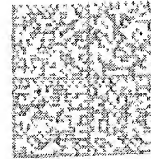
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